

REMARKS:

In the foregoing amendments, independent claims 1 and 21 were amended to correct an editorial error, where the minimum room temperature tensile strength was changed from "1273" to "1237." This amended minimum room temperature tensile strength is shown, for example, in run No. C of table 3 on page 19 of the present specification disclosure. Claim 21 was also amended by defining that the balance of Fe includes 20.6% or more Fe. Claims 1-21 remain in consideration by the examiner.

Claims 1-21 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Official action stated that the example relied upon by applicants in page 17, table 1, run No. C is "39.3" of Ni not "39.9" as set forth in claim 1.

Applicant respectfully submits that this rejection is moot. Namely, in the response after final filed January 10, 2006, table 1 on page 17 of the specification was amended to correct a typographical error by correcting the amount of Ni in Working Example (run) No. C of table 1 from "39.3" to "39.9." This amendment was made under the provisions of 37 C.F.R. § 1.57 for incorporation by reference. This typographical error was created when the application was translated from prior Japanese patent application No. 2003-073822, filed March 18, 2003. The present application claims priority from this prior Japanese patent application under the provisions of 35 U.S.C. § 119. A copy of this prior Japanese application was filed together with a claim to priority in this application on May 13, 2005. A copy of Japanese patent publication No. 2004-277860A, which was published on May 14, 2003, and which corresponds to Japanese patent application No. 2003-073822, was attached hereto to the response after final filed January 10, 2006. Table 1 is contained in the attached Japanese publication on page 8 thereof. Table 1 is

- 7 -

Application No. 10/803,054

Attorney Docket No.: VX047607

also contained in prior Japanese patent application No. 2003-073822 at a similar location within the text thereof. The present application is an English translation of Japanese patent application No. 2003-073822 with an exception of a typographical error in table 1. Viewing table 1, as shown in Japanese patent publication No. 2004-277860A, it can be seen that the amount of Ni in run No. C is "39.9," that supports the aforesaid amendment to applicants specification.

The applicant's specification disclosure, as amended, shows that the amount of nickel (Ni) is "39.9" in table 1, run No. C, and thus the presently claimed lower limit for nickel of "39.9" is supported in applicant's specification disclosure. Therefore, applicant respectfully requests that the examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph.

Claim 21 was rejected under 35 U.S.C. §112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Official action stated that the expression "balance Fe includes 20.6% Fe" is vague and indefinite because a point cannot support a range. Secondly, the Official action stated that it is unclear if "20.6 wt. %" is an upper limit or a lower limit of Fe.

While the applicant does not agree with this rejection, in the foregoing amendments the amount of Fe in claim 21 was changed to read: "and the balance Fe, where the balance Fe includes 20.6% or more Fe." The positions set forth in the outstanding Office action appeared to be that claiming a concentration of 20.6%, itself, is vague and indefinite. In the foregoing amendments, applicant's claim 21 was amended to include the concentration of 20.6% as a lower limit of a range, namely, where the balance Fe includes 20.6% or more Fe. For these reasons, applicant respectfully submits that claim 21 particularly points out and distinctly claims the subject matter regarded as the invention within the meaning of 35 U.S.C. §112, second

paragraph. Therefore, applicant respectfully requests that the examiner reconsider and withdraw this rejection.

The Official action set forth a single prior art rejection of applicant's claims 1-21 under 35 U.S.C. §103 as being unpatentable over EP 0639654 of Sato *et al.* (Sato). This rejection appears on pages 3 through 6 of the Official action. Among other things, the Official action stated that the properties in tables 1-6 fail to show unexpected advantages of the presently claimed amounts of Al and Ti/Al ratio, because all the properties of the presently claimed invention overlap those of the control alloys. Applicant cannot agree with the reasons proffered for this conclusion of obviousness in the outstanding Office action for reasons including those set forth in the Voluntary Amendment filed April 10, 2006, which are incorporated herein by reference.

The data shown in tables 1-6 of the present application demonstrate that there is no predictability or expectation of success by routine optimization of amounts of individual elements in the alloy as presently claimed. By establishing that there is no predictability or expectation of success by routine optimization of amounts of individual elements in the alloy as presently claimed, the data shown in tables 1-6 of the present application rebut the alleged *prima facie* case of obviousness over the teachings of Sato. For example, run No. 2, which contains an amount of Fe, Al and Al/Ti ratio all outside the range of applicant's claims satisfies none of the properties set forth in claim 1. Run No. 1 is the only comparative example having an Al/Ti ratio within applicant's claimed range. Run No. 1 has four properties outside the range set forth in the present claims. Run Nos. 3 and 4 have an Al/Ti ratio above that required an applicant's claims, while Run Nos. 2 and 5 have an Al/Ti ratio below that required an applicant's claims. Comparing run Nos. 3 and 4 with run No. 1 concerning the Al/Ti ratio, increasing this ratio from

within applicant's claims to outside that set forth in applicant's claims can result in different properties outside the range as set in forth applicant's claims. On the other hand, comparing run Nos. 2 and 5 with run No. 1 concerning the Al/Ti ratio, decreasing this ratio from within applicant's claims to outside that set forth in applicant's claims can result in more properties outside the range of applicant's claims or a smaller number of properties outside the range set forth in applicant's claims. From this information, applicant respectfully submits that one of ordinary skill in the art would believe that it is impossible to routinely modify the amount of Fe, Al and/or ratio of Al/Ti to that that presently claimed, because modification thereof can result in different properties being within and outside the range of applicant's claims and more or less properties outside the range set forth in applicant's claims. For these reasons, applicant respectfully submits that the data in tables 1-6 of the present application demonstrate the unexpected nature or unpredictable nature of the invention defined in the present claims. For at the least of these reasons, one of ordinary skill in the art could not be motivated to the invention defined in the present claims from the teachings of Sato.

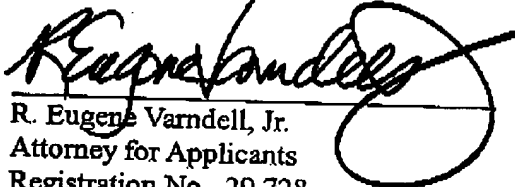
For the foregoing reasons, applicant respectfully submits that the presently claimed inventions are patently distinguishable from the teachings of Sato. Therefore, applicant respectfully requests that the examiner reconsider and withdraw this rejection.

For all these reasons, applicant respectfully submits that the invention set forth in claim 1, as well as the claims that depend thereon, and claim 21 are patently distinguishable from the teachings of Sato. Therefore, applicant respectfully requests that the examiner reconsider and withdraw all the rejections set forth in the outstanding Office action and allow claims 1-21.

While it is believed that the present response places the application in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolved any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which may become due, may be charged to our deposit account No. 50-1147.

Respectfully submitted,
POSZ LAW GROUP, PLC


R. Eugene Varndell, Jr.
Attorney for Applicants
Registration No. 29,728

12040 South Lakes Drive
Suite 101
Reston, Virginia 20191
Tel: (703) 707-9110
Fax: (703) 707-9112

D:\2006\8UGA\XX042602\PO60-2602 Resp 12.22.06.doc

- 11 -

Application No. 10/803,054
Attorney Docket No.: VX042602